

REMARKS

The present patent application has been reviewed in light of the Office Action, dated May 3, 2007, in which claims 18-19, and 21-24 are rejected under 35 U.S.C. § 102(b) as being anticipated by Beckert et al., U.S. Patent No. 6,202,008 (hereinafter "Beckert"). Claims 27-30 and 32-36 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Beckert. Claims 20 and 26 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Beckert in view of Kagle et al., U.S. Patent No. 6,601,056 (hereinafter "Kagle"). Claim 25 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Beckert in view of Jones et al., U.S. Patent No. 6,438,638 (hereinafter "Jones"). Claims 31 and 36 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Beckert in further view of Jones. Reconsideration of the above-referenced patent application in view of the foregoing amendments and following remarks is respectfully requested.

Claims 18-45 are pending. Claims 18-21, 25-28, and 32-33 have been amended. Assignee has amended claims to more clearly delineate intended subject matter. Amendments to claims are made without prejudice or disclaimer. New claims 40-45 have been added. No new matter has been added. Support for new claims 40-45 may be found, for example, at least at Figures 1-3.

Rejections under 35 U.S.C. § 102(b)

Claims 18-19, and 21-24 are rejected under 35 U.S.C. § 102(b) as being anticipated by Beckert. Assignee respectfully traverses the rejection. Beckert does not disclose "a digital video and audio decompressing card" as recited in amended claim 18. In the Office Action, the Examiner points to Column 6, lines 12-16 of Beckert

to support the assertion that Beckert discloses a digital video and audio decompressing card. However, that passage of Beckert reads as follows:

“The support module 62 also includes an audio signal processor 96 to perform the sound processing algorithms which may include: sound equalization, digital crossover, bass, treble, volume, surround sound, Dolby pro-logic™, AC-3 and MPEG decoding.” (Beckert, column 6, lines 12-16)

There is no disclosure in Beckert of “a digital video and audio decompressing card” as recited in amended claim 18. In addition to the lack of disclosure regarding a video and audio decompressing card, the support module 62 of Beckert does not include video functions. See, for example, Figure 6 of Beckert.

Claims 27 and 32 include similar limitations. Therefore, independent claims 18, 27, and 32, and the claims that depend from them, are believed to patentably distinguish from the cited patent. It is, therefore, respectfully requested that the Examiner withdraw the rejection as to these claims.

It is noted that claimed subject matter may be patentably distinguished from the cited patent for additional reasons; however, the foregoing is believed to be sufficient.

Rejections under 35 U.S.C. § 103(a)

Claims 27-30 and 32-36 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Beckert. Claims 20 and 26 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Beckert in view of Kagle. Claim 25 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Beckert in view of Jones. Claims 31 and

36 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Beckert in further view of Jones. Assignee respectfully traverses these rejections.

The Examiner is reminded that to successfully make a prima facie rejection under 35 USC § 103, the Examiner must show that Assignee's claimed subject matter would have been obvious to one of ordinary skill in the art pertinent to Assignee's claimed subject matter at the time it was made. See KSR International, Co. v. Teleflex, Inc., 550 U.S. ____ (decided April 30, 2007). Some of the factors to consider in this analysis include the differences between the applied documents and Assignee's claimed subject matter, along with the level of skill associated with one of ordinary skill in the art pertinent to Assignee's claimed subject matter at the time it was made. See USPTO Memo entitled "Supreme Court decision on KSR Int'l. Co., v. Teleflex, Inc." (May 3, 2007). One way in which an Examiner may establish a prima facie case of unpatentability under 35 USC § 103 would be to show that three basic criteria have been met. First, the Examiner should show that the applied documents, alone or in combination, disclose or suggest every element of Assignee's claimed subject matter. Second, the Examiner should show that there is a reasonable expectation of success from the proposed combination. Finally, the Examiner should show that there was some suggestion or motivation, either in the applied documents themselves or in the knowledge generally available to one of ordinary skill in the art pertinent to the claimed subject matter at the relevant time, to modify the document(s) or to combine document teachings. The motivation or suggestion to make the proposed combination and the reasonable expectation of success should be found in the prior art, and should not be based on Assignee's disclosure. See In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); See MPEP § 2142; § 2143 - § 2143.03 (regarding decisions pertinent

to each of these criteria). It is respectfully asserted that the Examiner has not met these standards.

The applied documents, whether applied individually or in combination, do not teach or suggest all of the elements of the aforementioned claims. As discussed above, Beckert does not disclose "a digital video and audio decompressing card " as recited in amended claim 18. Kagle and Jones also do not disclose this element of claim 18. Therefore, any combination of Kagle, Beckert, and Jones would not yield all of the limitations of claim 18, and therefore claim 18 patently distinguishes over the applied documents. Claims 27 and 32 include similar limitations. Therefore, independent claims 18, 27, and 32, and the claims that depend from them, are believed to patentably distinguish from the applied patents. It is, therefore, respectfully requested that the Examiner withdraw the rejections as to these claims.

It is noted that claimed subject matter may be patentably distinguished from the applied documents for additional reasons; however, the foregoing is believed to be sufficient to overcome the Examiner's rejections discussed above.

Further, it is noted that the Assignee's failure to comment directly upon any of the positions asserted by the Examiner in the office action does not indicate agreement or acquiescence with those asserted positions since the Examiner's other positions are believed to be moot in light of the foregoing.

CONCLUSION

In view of the foregoing, it is respectfully asserted that all of the claims pending in the present patent application are in condition for allowance. If the Examiner has any questions, he is invited to contact the undersigned at (503) 439-6500. Reconsideration of the present patent application and early allowance of all the claims is respectfully requested. Please charge any underpayments or credit any overpayments to deposit account no. 50-3703.

Respectfully submitted,

Dated: 8/16/07

/Calvin E. Wells Reg. No. 43,256/
Calvin E. Wells
Reg. No. 43,256

Customer No. 43831
Berkeley Law and Technology Group, LLP
17933 NW Evergreen Parkway, Suite 250
Beaverton, OR 97006
Phone: 503.439.6500

cc: Docketing